

(b) the embodiment wherein the main constituent of the molding is high impact polystyrene;

(c) the embodiment wherein the main constituent of the molding is modified polyphenyl oxide (ether);

(d) the embodiment wherein the main constituent of the molding is polypropylene; and

(e) the embodiment wherein the main constituent of the molding is polyethylene.

Applicants elect, with traverse, species (a). Claims 1-8, 12-29 and 32-58 read on the elected species.

The Office, citing PCT Rules 13.1 and 13.2, contends that the species lack unity of invention because they are not so linked so as to form a single general inventive concept.

The Election Requirement is respectfully traversed. The Applicants note that the PCT administrative instructions in the MPEP, Annex B, Part 1(f) define Markush practice and state that the alternatives defined in a single claim shall meet the technical relationship requirements of PCT Rule 13.2 if they are of a similar nature. These alternatives shall be regarded as being of a similar nature when the following criteria are fulfilled:

(A) all the alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The Office provides no support for its conclusion that the alternative chemical compounds in the claims are so dissimilar that they fail to meet the requirements of PCT Rule 13.2 for Markush practice.

Applicants further traverse the Restriction Requirement on the ground that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the international application and examined all claims together. Applicants note that PCT Article 27(l) states that no national law shall require compliance with requirement relating to the form and contents of the international application different from or additional to those which are provided for the Patent Cooperation Treaty and the Regulations. In light of PCT Article 27(l) and 37 C.F.R. §145 and §1.499, it is apparent that when the International Preliminary Examination Authority finds no objection based on lack of unity of invention, there is a special burden on the Office to explain why its conclusions are diametrically opposed to those of the International Preliminary Authority, as approved by treaty.

Finally, Applicants respectfully submit that the Office has not shown that a serious burden exists in searching the entire application. In fact, the International Searching Authority has searched all of the claims together.

For the reasons set forth above, Applicants contend that the Election of Species Requirement is improper and should be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Kirsten Grueneberg

Norman F. Oblon
Attorney of Record
Registration No. 24,618

Kirsten A. Grueneberg, Ph.D.
Registration No.: #47,297



22850

PHONE: (703) 413-3000
FAX: (703) 413-2220
NFO:KAG:ekd
I:\user\KGRUN\98290001.erq.wpd